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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

S104.12-0051/STL11003

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on October 14, 2005

Signature Diana C. Anderson

Typed or printed name Diana C. Anderson

Application Number

10/659,616

Filed

September 10, 2003

First Named Inventor

John Frederick Runyon

Art Unit

3683

Examiner

Robert Siconolfi

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

applicant/inventor.

assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

attorney or agent of record.

Registration number 38,794

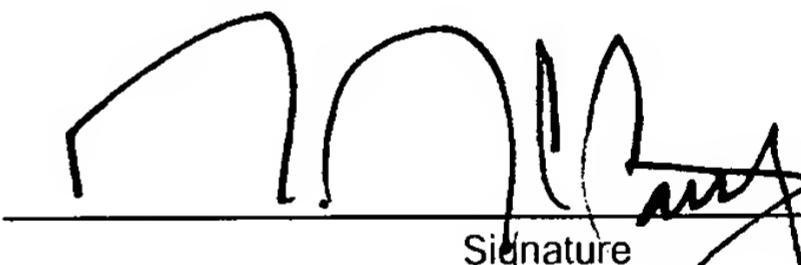
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Registration number if acting under 37 CFR 1.34

Date



Signature

Mitchell K. McCarthy

Typed or printed name

*Total of 1 forms are submitted.

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PATENT
Dkt. S104.12-0051/STL11003

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: **John Frederick Runyon**
Assignee: **SEAGATE TECHNOLOGY LLC**
Application No.: **10/659,616** Group Art: **3683**
Filed: **September 10, 2003** Examiner: **Robert Siconolfi**
For: **FLUID ISOLATOR ASSEMBLY AND FLOATING ELASTOMERIC DAMPING ELEMENT**

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**APPLICANT'S REMARKS ACCOMPANYING PRE-APPEAL
BRIEF REQUEST FOR REVIEW**

Sir:

Please enter the following remarks as Applicant's basis for this Pre-Appeal Brief Request for Review. Generally, this review is necessary and proper because the independent claims stand finally rejected without a completely substantiated basis for the rejections. The Applicant is entitled to a patent unless the invention was previously patented or described. 35 U.S.C. 102 An appealable rejection requires a complete examination: "The examination shall be complete with respect to...the patentability of the invention as claimed. 37 C.F.R. 1.104(a). A complete examination substantiating a Section 102 rejection provides a single reference that identically discloses all the recited features of the rejected claim. The prosecution process, when properly executed, is designed to define the issues on appeal by both the Applicant and Examiner fully setting forth the reasons for and against patentability. When the Examiner maintains anticipatory rejections without fully substantiating them, then the

Applicant is left facing an appeal brief with a distinct disadvantage that is not contemplated by law, due to a case not in condition for appeal for a lack of clearly defined issues.

IT IS CLEAR ERROR THAT THE EXAMINER HAS NOT SUBSTANTIATED THE ANTICIPATORY FINAL REJECTION OVER HARRISON '388 FOR THE *CENTRAL MEMBRANE PORTION OF CLAIM 1*

The Applicant has repeatedly argued that Harrison '388 does not identically disclose a *diaphragm with a central membrane portion* that is disposed *substantially parallel to the base*. (see **Applicant's Response of 3/29/05, ppg. 10-11; Applicant's Response of 9/14/2005, ppg. 10-11**)

The Examiner is nonresponsive to Applicant's argument. Instead, the Examiner has deflected Applicant's argument by replying that a non-membrane portion of the diaphragm in Harrison '388 is disposed parallel to the base. (see **Office Action of 7/14/2005, pg. 3**) The Applicant has replied that it is irrelevant that Harrison '388 discloses a feature not claimed.

The Examiner's final rejection fails to satisfy the requirement of completeness with respect to the "patentability of the invention as claimed" that is dictated by 37 C.F.R. 1.104(a). In the absence of a rebuttal, this leaves the Applicant wrongfully disadvantaged in wondering whether the Examiner by silence has acquiesced to Applicant's argument; and if so, whether there might be some unexplained reasoning for the rejection. In any event, the Applicant is entitled to a patent unless the Examiner substantiates a rejection. Here, the Examiner has not fully substantiated a basis for the Section 102 rejection by providing a single reference that identically discloses all the recited features of the rejected claim. This unresolved issue must be addressed before this case is in condition for appeal.

IT IS CLEAR ERROR THAT THE EXAMINER HAS NOT SUBSTANTIATED THE ANTICIPATORY FINAL REJECTION OVER YANAGISAWA '303 FOR THE *DIAPHRAGM AND THE BASE COOPERATIVELY DEFINING A SEALED CHAMBER OF CLAIM 1*

The Applicant has argued that Yanagisawa '303 does not identically disclose *the diaphragm and the base cooperatively defining a sealed chamber.* (see Applicant's Response of 9/14/2005, pg. 15)

Again, the Examiner is nonresponsive to Applicant's argument. Although the Examiner admittedly may have the discretion to finally reject claims on a newly cited reference, that discretion in no way diminishes the Examiner's obligation to make a complete examination with respect to the patentability of the invention as claimed. 37 C.F.R. 1.104(a).

The Examiner's final rejection fails to satisfy the requirement of completeness with respect to the "patentability of the invention as claimed" that is dictated by 37 C.F.R. 1.104(a). In the absence of a rebuttal, this leaves the Applicant wrongfully disadvantaged in wondering whether the Examiner by silence has acquiesced to Applicant's argument; and if so, whether there might be some other unexplained reasoning. In any event, the Applicant is entitled to a patent unless the Examiner substantiates a rejection. Here, the Examiner has not fully substantiated a basis for the Section 102 rejection by providing a single reference that identically discloses all the recited features of the rejected claim. This unresolved issue must be addressed before this case is in condition for appeal.

IT IS CLEAR ERROR THAT THE EXAMINER HAS NOT SUBSTANTIATED THE ANTICIPATORY FINAL REJECTION OVER HARRISON '388 FOR *DAMP(ING)...HIGH FREQUENCY...VIBRATION(S)* OF CLAIMS 10, 18, AND 21

The Applicant has argued that Harrison '388 does not identically disclose, and the skilled artisan readily recognizes it to be inherently incapable of, damping high frequency vibrations as variously claimed in independent claims 10, 18, and 21. (for claim 10 see Applicant's Response of 2/29/2005, pg. 11 and Applicant's Response of 9/14/2005, pg.

11-13; for claim 18 see Applicant's Response of 2/29/2005, pg. 12 and Applicant's Response of 9/14/2005, pg. 13-14; for claim 21 see Applicant's Response of 2/29/2005, pg. 12 and Applicant's Response of 9/14/2005, ppg. 14-15)

The Examiner rebutted Applicant's argument by stating that Harrison '388 discloses different damping elements that will damp different frequencies of vibration; that is, "one will damp a lower frequency and one will damp a higher frequency." (see **Office Action of 7/14/2005, pg. 3**)

Applicant has argued in response that the Examiner's reading of the damping of a comparatively higher of two low frequency vibrations in Harrison '388 onto the claimed damping of high frequency vibrations requires an unreasonably broad construction. This is because one skilled in the art readily recognizes the term "high frequency vibrations" to have ordinary meaning, consistent with its usage in the specification, and associated with the spectral range beyond that of simple mechanical vibrations to vibrations associated with high speed electromechanical vibrations such as motor rotation, highly accelerated components, and the like.

The Examiner apparently does not disagree with Applicant that "high frequency vibration" is a term of art with ordinary meaning. The Examiner stated:

Applicants further argue that oen [sic] skilled in the art would know the meaning of high frequency vibrations. The applicant fails to mention to what art they are referring. Different fields consider different ranges to be high frequency.

(Advisory Action of 10/6/2005, pg. 2, emphasis added)

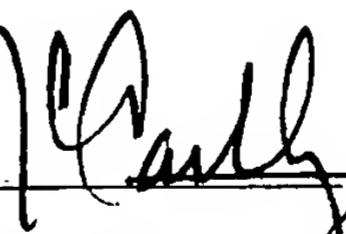
The Examiner thus agrees the claim term "high frequency" ascribes ordinary meaning that is distinguishable from "higher frequency." Given that meaning, however, the Examiner

has not substantiated a basis for Harrison '388 identically disclosing "damping high frequency."

Again, the Examiner's final rejection fails to satisfy the requirement of completeness with respect to the "patentability of the invention as claimed" that is dictated by 37 C.F.R. 1.104(a). This leaves the Applicant wrongfully disadvantaged in wondering whether the Examiner, by admitting the ordinary meaning of the claim term but not substantiating the rejection by applying the cited reference according to it, might have some other unexplained reasoning. In any event, the Applicant is entitled to a patent unless the Examiner substantiates a rejection. Here, the Examiner has not fully substantiated a basis for the Section 102 rejection by providing a single reference that identically discloses all the recited features of the rejected claim. This unresolved issue must be addressed before this case is in condition for appeal.

Conclusion

Accordingly, for at least these reasons the Applicant believes this case is not in condition for appeal. Withdrawal of the final rejection of all claims for further prosecution on the merits to completion is respectfully requested.

Respectfully submitted,
By: _____ 

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